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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,066	10/13/2000	Dr. Biancamaria Prozzo	TP/2-22108/A/PFE 287	1274

7590

03/01/2004

Ciba-Specialty Chemicals Corporation
Patent Department
540 White Plains Road
PO Box 2005
Tarrytown, NY 10591-9005

EXAMINER

KUMAR, PREETI

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,066

Applicant(s)

PROZZO ET AL.

Examiner

Preeti Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 7-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Final Rejection

1. Claims 2-5, 7-9 and 11-13 are pending.
2. The rejection of claims 2-5, 7-8 under 35 U.S.C. 103(a) as being unpatentable over Stringer et al. (US 5,858,955) is maintained for the reasons recited in the previous office action and further described below.
3. The rejection of claims 9 and 11-12 under 35 U.S.C. 103(a) as being unpatentable over Gosselink et al. (US 5,691,298) in view of Stringer et al. (US 5,858,955) is withdrawn upon further review and reconsideration.

Response to Arguments

4. Applicant's arguments filed November 7, 2003 have been fully considered but they are not persuasive because the prior art made of record is sufficient to overcome the material limitations of the claims as amended. As clearly stated in prior office actions, Stringer et al. provide suggestion to incorporate components A-D in a composition for use in the pretreatment of fiber materials.
5. In response to applicant's argument that the amendment of claim 8 directed now to *a process for the pretreatment of fiber materials in the form of textile sheets, said process being performed prior to manufacture of enduse articles from the sheets* gives life and meaning to the claim is not valid or supported by the Applicant's specification. Applicant's cite the disclosure on page 3 lines 4-8, for the criticality of this limitation, however upon review of this citation no support was found. Contrary to applicant's arguments, the disclosure recites that "...the object of the present invention is to

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develop a composition which has excellent utility for the pretreatment of fiber materials, especially textile sheet materials...". See page 3 lines 4-8. No support for the criticality of the process being performed prior to manufacture of enduse articles is found in the disclosure. Further proof of lack of criticality can be found on page 10, lines 1-5, where Applicant's recite that "Compositions according to the invention are very useful for treating fiber materials, expecially for pretreating textile fiber materials in the form of wovens of knits." Thus, Applicant's arguments that the instant claim distinguishes the inventive process from processes which are performed at other stages of fiber or fabric processing and thereby gives life and meaning to the claim is not found to be persuasive or pertinent since applicant's disclosure provides no support of basis for the cited criticality.

6. Regarding applicant's argument on page 7, that the composition is not known and that the process is a different one from Stringer et al., examiner draws attention to specifically regarding component A Stringer et al. teach the utility of sodium cumene sulfonate which meets the limitation of formula I as recited by the applicants in claim 8 and on page 11 of the specification. Specifically regarding component B, Stringer et al. teach the utility of primary aliphatic alcohol ethoxylates, and secondary aliphatic alcohol ethoxylates, alkylphenol ethoxylates. See col.5, ln.25-30. Specifically regarding component C, Stringer et al. teach the utility of a C10 -C16 alkanol condensate with ethylene oxide and propylene oxide, the weight ratio of ethylene oxide to propylene oxide being 3:1 and the total alkoxy content being about 75% by weight. See col.6, ln.34-36. Specifically regarding component D, Stringer et al. teach a light duty liquid

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cleaning composition comprising water. See col.4, ln. 48. Accordingly, Stringer et al. provide suggestion to incorporate components A-D in a cleaning composition in a process performed on fiber materials to remove impurities.

7. On page 8, Applicant's urge that the combination of desirable properties shown in Table II on page 12 for the compositions of inventive examples 1, 2, 5, and 6, are surprising and unexpected. However, contrary to applicant's arguments, examples 1, 2, 5, and 6, are not commensurate in scope with the claimed limitations of the instant claims. The instant claims are drawn to a very broad range of components within the cited formulas I-V and the examples of tables I and II are limited to specifically methyl 1,5 pentanediol, sodium cumenesulfonate, ethoxylated C13 alcohol, and ethoxylated/propoxylated C12-C18 alcohol. Also the inventive examples are not surprising and unexpected since example 6 is representative of the combination of desirable properties as recited by the instant claims and has the same primary wettability and rewettability values as illustrated by comparative example 4. Furthermore the specification does not make it clear if the ISO 8022 method is a standard for determining primary wettability. Also no standard method is provided for measuring the rewettability. Finally, regarding the foaming, no standard is provided for quantifying the amount of foam in the rating of "very pronounced" as illustrated by comparative example 4 and "moderate" as shown in the representative example 6. Thus, the examples in table II are not found to be surprising or unexpected.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2-5, 7-9 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding independent claim 8, the phrase "good primary wettability with out unacceptable foaming and good rewettability" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "good" and "unacceptable"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). The terms "good" and "unacceptable" in claim 8 are relative terms that render the claim indefinite. The terms "good" and "unacceptable" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Also regarding claim 8, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Preeti Kumar
Examiner
Art Unit 1751

PK



**MARGARET EINSMANN
PRIMARY EXAMINER
GROUP 1100**